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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,731	04/26/2005	Serge Auvin	427.095	6471

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EXAMINER	
HABTE, KAHSAY	
ART UNIT	**PAPER NUMBER**
1624	

MAIL DATE	DELIVERY MODE
07/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/532,731	AUVIN ET AL.	
	Examiner	Art Unit	
	Kahsay Habte	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 June 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-4 are pending in this application.

Response to Amendment

2. Applicant's amendment filed 6/20/2007 in response to the previous Office Action (2/27/2007) is acknowledged. Rejection of claims 1-4 and 11-14 under 35 U.S.C. § 112, first and second paragraph (items 2 and 3c) have been obviated. Rejection of claims 1-4 and 11-14 under 35 U.S.C. § 112, second paragraph (item 3a-3b), the statutory type (35 U.S.C. 101) double patenting rejection and the obviousness-type double patenting rejection (items 5 and 7) has been maintained.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

a. In claim 1, the phrase "AA...selected from the group consisting of a natural amino acid, a natural aminoacid the side chain of which, which carries a reactive chemical function, is protected in the form of alkyl or aralkyl ester -(for the acid function)-, in the form of alkyl or aralkyl ether or alkyl or aralkyl thioether or in the form 1f

alkyl or aralkyl ester –(for the alcohol and thiol functions)- and finally an amino acid of the formula…" is not clear. The definition of AA appears to be garbled. It is unclear what "for the acid function" mean, what "form 1f" mean etc. What is reactive chemical function in the form of alkyl or aralkyl ester? What is in the form of alkyl mean? It is recommended that applicants review the definition of AA and recite specific substituents.

Response to arguments

Applicant's argument filed 06/20/2007 has been fully considered but it is not persuasive.

Applicants argue, "Applicants traverse these grounds of rejection as the amended claims are believed Clear". The examiner disagrees with applicants. The claim remains unclear. Applicants have not amended or recited specific substituents to overcome the rejection. It is recommended that applicants recite specific substituents for AA. Suggested language is "AA is selected from the group consisting of natural amino acid and NR^{14}-$(CH_2)_pCR^{15}R^{16}$-CO-….".

b. In claim 1, the phrase "-$(AA)_2$- also being able to be NR^{17}-$(CH_2)_3CHR^{18}$-CO-" is not clear. What is the definition of -$(AA)_2$- if it is not able to be NR^{17}-$(CH_2)_3CHR^{18}$-CO-? What is the definition of $(AA)_3$? It is recommended that applicants amend the claim as "-$(AA)_2$- is NR^{17}-$(CH_2)_3CHR^{18}$-CO-".

Response to arguments

Applicant's argument filed 06/20/2007 has been fully considered but it is not persuasive.

Applicants argue that "The missing comma has been supplied to the R definition and 'carbapeptide' no longer appears in claim 1. The definition of AA has been clarified and withdrawal of these rejections is requested". The examiner disagrees with applicant's argument. Applicants have only deleted "carbapeptide", but not addressed the issue completely.

Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 1-3 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-3 of copending Application No. 11/115,480. This is a

provisional double patenting rejection since the conflicting claims have not in fact been patented.

Response to arguments

Applicant's argument filed 06/20/2007 has been fully considered but it is not persuasive.

Applicants did not address this issue. Instant claims 1-3 and claims 1-3 of copending Application No. 11/115,480 is exactly the same. Applicants have to delete claims 1-3 from the instant case or said copending application to overcome this rejection.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 11/115,480. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is significant overlap between the instant claims and the claims of the copending application. Note that all the species recited in claim 4 of the copending application 11/115,480 are present in the instant claim 4.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to arguments

Applicant's argument filed 06/20/2007 has been fully considered but it is not persuasive.

Applicants filed a terminal disclaimer to overcome this rejection, but the terminal disclaimer was defective. According to the paralegal "the company name and the serial number in the terminal disclaimer is not clear". Based on this information, the examiner notified applicants on July 7, 2007 the problem and requested that they send a replacement terminal disclaimer via fax directly to the examiner, but applicants did not send one.

Note that if the obviousness-type double patenting rejection is the only remaining issue in this early filed case, the obviousness-type double patenting rejection would be dropped.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte whose telephone number is (571)-272-0667. The examiner can normally be reached on M-F (9.00- 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kahsay Habte
Primary Examiner
Art Unit 1624

July 10, 2007